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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/598,783 | 09/11/2006 | Rickard Carlsson | BERGLUNDS P0320 CIP | 1331 |
| 27667 | 7590 | 11/17/2009 | | |
| HAYES SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718 | | | EXAMINER LAMB, BRENDA A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1792 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 11/17/2009 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/598,783 | Applicant(s) CARLSSON ET AL. | |
| | Examiner Brenda A. Lamb | Art Unit 1792 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-34 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-34 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 26-29, 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen 5,265,509.

Chen teaches the design of a dispenser which is comprised of the following elements: a motor drive 50 for dispensing the substrate; a cutting tool 6 for cutting the substrate to a desired length; a sprayer or nozzle 34 for spraying a material; control electronics for feeding different amounts of material on the substrate (column 3 line 59 to column 4 line 14). Chen teaches his apparatus includes using a folded substrate perpendicular to the longitudinal direction of the substrate. Chen teaches at column 4 lines 20-26 that the dispenser is refillable without disposing of partly used stacks but fails to teach a paper magazine/paper chamber is refillable from below. However, it

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prima facie obvious to invert the Chen dispenser to insert the stack of folded paper/substrate into the bottom opening of the paper magazine/paper chamber to facilitate loading of the paper/substrate without contacting the guide rolling system 21 until the user is ready to feed the paper/substrate through the dispenser. Chen dispenser as modified is capable of dispensing a substrate within the scope of the claim since it teaches every element of the claimed apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Thus claims 26-29 AND 32 are obvious over Chen et al. With respect to claim 34, Chen teaches that the perforator in his apparatus can include a knife with a number of adjacent knife tips or saw-toothed cutting edge.

Claims 30-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen 5,265,509 in view of Watanabe 5,131,302.

Chen is applied for the reasons noted above but fails to teach the contact free activation sensor and rubber rings contacting the paper. However, Watanabe teaches the design of a dispenser which is comprised of the following elements: a motor drive for dispensing the paper; a sensor 34 for sensing movement of the user's hand in front of the sensor to provide contact free activation of dispensing of paper therefrom; a cutting tool (elements 24b,24a) for cutting the substrate to a desired length; and a

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feeding device including on a roller (elements 10,11) arranged with rubber rings that are in contact with paper. Watanabe dispenser is capable of dispensing a substrate within the scope of the claim since it teaches every element of the claimed apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Therefore, it would have been obvious given the modifications of the Chen dispenser as discussed above to include a contact free activation sensor such as taught by Watanabe to activate the rollers to dispense paper through the dispenser for the obvious advantage of automation of the dispensing process by the user – increase ease of use. Further, it would have been obvious given the modifications of the Chen dispenser as discussed above to provide rubber rings on the roller contacting the paper as taught by Watanabe to obviously enable one to firmly grip the paper for movement through the dispenser.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen 5,265,509 in view of DiSanto.

Chen is applied for the reasons noted above. Chen fails to teach his dispenser system is swivelable or pivotable. However, DiSanto teaches the use of at least pivotable shelf in a dispenser system to obviously enable one provide greater access of the interior of the housing (see DiSanto at column 2 lines 13-23). Therefore, it would

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have been obvious to modify the Chen paper dispensing system by pivotably or swivelably mounting at least one of its separating wall between one of its compartments since DiSanto teaches pivotably or swivelably mounting its shelving system in a housing system to obviously enable one provide greater access of the interior of the housing (see DiSanto at column 2 lines 13-23). Note Chen's upper lid 16 is pivotable secured to the remainder of the container 1 and the upper lid can serve as a shelf on which the user can at least temporarily store items and therefore Chen's pivotably secured upper lid reads on swivel or pivotably mounted shelf.

Applicant's arguments filed 7/7/2009 have been fully considered but they are not persuasive.

Applicants' argument that Chen's paper magazine is refillable from below and new paper is joined to paper existing in the magazine is found to be non-persuasive. As discussed above, it prima facie obvious to invert the Chen dispenser to insert the stack of folded paper/substrate into the bottom opening of the paper magazine/paper chamber to facilitate loading of the paper/substrate without contacting the guide rolling system 21 until the user is ready to feed the paper/substrate through the dispenser. Further, the Chen dispenser is capable of dispensing a stack of paper which is joinable end to end with another stack.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

De Luca teaches a stack of paper which is joinable end to end with another stack such that when one stack is exhausted then another stack of paper is drawn through the dispenser opening without having to re-thread the dispenser.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Wednesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton, can be reached on (571) 272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brenda A Lamb
Primary Examiner
Art Unit 1792

/Brenda A Lamb/

Primary Examiner, Art Unit 1792